



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/597,477

01/16/2007

Kathleen O. Havelka

3268-01

1728

26645

7590

07/30/2009

THE LUBRIZOL CORPORATION  
ATTN: DOCKET CLERK, PATENT DEPT.  
29400 LAKELAND BLVD.  
WICKLIFFE, OH 44092

EXAMINER

WIECZOREK, MICHAEL P

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

07/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,477	<b>Applicant(s)</b> HAVELKA ET AL.	
	<b>Examiner</b> Michael Wieczorek	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-32 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/27/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) claims 1 through 23 and 33 through 36, drawn to a tinting composition.

Group II, claim(s) 24-32 and 37, drawn to a method for applying a tinting composition.

### ***Lack of Unity***

2. Lack of unity of invention may be may only become apparent “a posteriori,” that is, after taking the prior art into consideration, in the case of independent claims to A + X and A + Y, unity of invention (i.e. species) is present a posteriori as A is common to both claims.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature which is referred to Annex B of Appendix A1 of the MPEP (Administrative Instructions under the PCT, “Unity of Invention”). The express “special technical features” is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art” (Rule 13.2). Unity exists **only** when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed special

Art Unit: 1792

technical features. In this case, the technical feature shared by each invention is a coating composition comprising a solvent, a film forming polymer.

The question of unity of invention has been reconsidered retroactively by the examiner in view of the search performed; a review of Roberts et al (U.S. Patent # 5,191,014), makes clear that the inventions of the groups I-II lack the same or corresponding technical feature because the cited reference(s) appear to demonstrate that the claimed technical feature does not define a contribution which each of the inventions, considered as a whole, makes over the prior art. Accordingly, the prior art of the record supports restriction of the claimed subject matter in to the groups as mentioned immediately above.

Roberts et al teaches a coating composition used to form a protective temporary coating (Abstract). The composition comprises a solvent in the form of water and film forming polymer in the form of particulate water-insoluble copolymers (Column 3 Lines 3-42). Thus there is no "special technical feature" linking groups I and II.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully

Art Unit: 1792

examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. During a telephone conversation with Sam Laferty on July 17, 2009 a provisional election was made to prosecute the invention of Group II, claims 24-32 and 37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-23 and 33-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Claim Objections***

5. Claim 32 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

Art Unit: 1792

claim(s) in independent form. Claims 32 discloses concentration ranges for the solvent and pigment components of the coating composition which are broader than the concentration ranges for those components disclosed in parent claim 24.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 24-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The term "slightly basic" in claim 24 is a relative term which renders the claim indefinite. The term "slightly basic" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The neither the claims nor the specification of the present application provide a clear definition on what pH or other characteristic is required for a solvent to be defined as "slightly basic". Clarification on this issue is requested.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1792

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 24-26, 28, 31-32 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al (U.S. Patent # 5,191,014) in view of Coombes et al (Patent # 4,562,226).

Roberts et al teaches a coating composition used for the formation of a temporary protective coating (Abstract). The coating composition is comprises of solvent in the form of water and film forming polymer in the form of particulate water-insoluble copolymers. Roberts et al teaches that the composition is a dispersion of these polymers in the water solvent thus making the film forming polymers dispersible in a polar solvent that does not applicable swell or etch a polymeric substrate since water is such a solvent. (Column 3 Lines 3-42)

Roberts et al further teaches mixing the solvent and film forming polymers along with dye pigments for the purposes of forming a colored coating, thus making the coating composition a tinting composition and other optional additives like thickeners, additives reducing the effects of ultraviolet radiation in the form of light stabilizers and corrosion inhibitors (Column 5 Lines 40-58).

Roberts et al further teaches applying the coating solution by selecting a surface to be coated and spraying the coating composition by spraying (Column 6 Lines 9-16).

Art Unit: 1792

Roberts et al further teaches that the taught composition forms a rain thus water resistant coating that can be removed by washing with a dilute alkaline aqueous solution (Column 3 Lines 49-56) and that the coating is applied to surfaces of plastic or painted surfaces (Column 1 Lines 7-12). Thus the formed film can be removed with a slightly basic polar solvent or solvent blend.

Roberts et al does not specifically teach that the dilute alkaline aqueous solution used to remove the coating does not swell or etch a polymeric substrate upon which the coating has been applied.

Coombes et al teaches a polymeric coating composition used for forming a temporary protective coating that is removable by an aqueous alkaline solution (Abstract). The coating composition further comprises pigments or dyes (Column 4 Lines 1-13).

Coombes et al further teaches the use of dilute alkaline aqueous solutions to remove the temporary protective coating and the use of such dilute alkaline aqueous solutions does not cause any damage to the underlying polymeric substrate during the removal of the temporary coating (Column 4 Lines 29-62 and Column 7 Lines 41-63).

At the time the present invention was made one of ordinary skill in the art would have a reasonable expectation of success in that the removal of the temporary coating by a slightly basic polar solvent or solvent blend would not cause the polymeric substrate to swell or be etched. Based on the teachings of Coombes et al, one of ordinary skill in the art would have a reasonable expectation of success in that a dilute alkaline aqueous solution used to remove the temporary coating of Roberts et al would not cause the polymeric substrate to be damaged and to thus not swell or be etched.



Art Unit: 1792

As for the limitation that the film forming polymer is in the coating composition in the amount of about 3 to about 25 wt%, Roberts et al teaches that the taught coating composition comprises from 5 to 30 wt% solid material excluding pigment (Column 5 Lines 62-68), thus the film forming polymer of the composition is in the amount of 5 to 30 wt% (in the absence of optional solid additives) which overlaps with the claimed range.

Overlapping ranges are *prima facie* evidence of obviousness. It would have been obvious to one having ordinary skill in the art to have selected the portion of the Roberts et al's film forming polymer concentration range that corresponds to the claimed range. *In re Malagari*, 182 USPQ 549 (CCPA 1974)

As for the limitations that the solvent is in the amount of about 75 to about 99.9 wt% and the pigment is in the amount of about 0.1 to about 15 wt%, Roberts et al does not teach this. The MPEP states, "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)."

Furthermore, the concentration of each component are considered result effective variables because the amount of solvent in the coating composition affects the viscosity of the coating composition and the length of time it takes for the coating to dry (i.e. the length of time for all of the solvent to evaporate) and the concentration of the pigment affects how dark or solid the color of the formed coating is.

Art Unit: 1792

At the time the present invention was made it would have been obvious to one having ordinary skill in the art to have determined the optimum values for the solvent and pigment concentrations of the coating composition of Roberts et al through routine experimentation in the absence of a showing of criticality.

As for claims 25, as was discussed above in the claims 24 rejection, Roberts et al teaches that the formed coating is removed by washing with a dilute alkaline aqueous solution or solvent blend that produces an environmentally acceptable effluent (Column 3 Lines 52-56), thus the solvent blend dissolves the film forming polymer. Furthermore, as was taught by Coombes et al the use of dilute alkaline aqueous solutions like those taught by Roberts et al do not cause any damage to the underlying polymeric substrate, so the use of the dilute alkaline aqueous solution or solvent blend would not cause etching of the polymeric substrate.

As for claims 26, as was discussed above, Roberts et al teaches applying the composition onto a surface by spraying.

As for claims 28 and 31, Roberts et al teaches that the coating composition is applied to plastic surfaces of newly manufactured motor vehicles and marine craft, thus to polymeric substrates, as well as painted surfaces of such vehicles (Column 1 Lines 7-12).

As for claim 32, as was discussed above in the claim 24 rejection it would have been obvious to one having ordinary skill in the art to have determined the optimal concentration ranges for the solvent and pigment components of the coating composition through routine experimentation in the absence of a showing of criticality.

In the case of claim 37, as was discussed above, Roberts et al teaches a method of applying a water-proof protective layer onto a surface by spraying the composition onto a

Art Unit: 1792

surface. Furthermore, as was discussed above, the taught composition comprises at least one water-proof film-forming polymer in the amount of 5 to 30 wt% which is encompassed by the claimed range of about 1 to about 50 wt%.

Roberts et al does not specifically teach that the composition comprises a solvent in the amount of about 55 to about 90 wt% but as was discussed above in the claims 24 rejection it would have been obvious to one having ordinary skill in the art to have determined the optimal ranges for the solvent concentration through routine experimentation in the absence of a showing of criticality.

12. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al in view of Coombes et al as applied to claim 24 above, and further in view of Swidler '436 (U.S. Patent # 5,281,436).

The teachings of Roberts et al as they apply to claim 24 have been discussed previously. Though Roberts et al teaches the step of applying the coating composition it does not teach that the application step includes one of sponging, dabbing, brushing, rolling or wiping the composition onto the surface. As was discussed previously, the invention of Roberts et al relates to a temporary protective polymeric coating applied to plastic and painted surfaces of motor vehicles and marine craft that can be removed by alkaline aqueous solutions.

Swidler '436 teaches a composition used for forming a temporary protective polymeric coating on the exterior surfaces of automobiles which can be removed by an alkaline aqueous solution (Abstract). Swidler '436 further teaches that the coating composition is applied to a surface by such known application techniques as brushing and spraying (Column 5 Lines 8-16).

Art Unit: 1792

At the time the present invention was made it would have been obvious to one having ordinary skill in the art to have applied the coating composition by brushing. As taught by Swidler '436, brushing and spraying are two known functional equivalent application methods known in the art for applying polymeric temporary protective coating composition to a surface. Thus one of ordinary skill in the art would have a reasonable expectation of success by applying the coating composition of Roberts et al to a surface by brushing.

13. Claims 29 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al in view of Coombes et al as applied to claim 28 above, and further in view of Swidler '044 (U.S. Patent # 6,124,044).

The teachings of Roberts et al as they apply to claim 28 have been discussed previously. Roberts et al teaches that the taught composition is applied to plastic or painted surfaces of motor vehicles to protect the coated surfaces from such things as rain (Column 1 Lines 7-36). But neither Roberts et al nor Coombes et al specifically teach that the coated or plastic substrates of the automobiles include tires, dashboards, bumpers, steering wheels, mud-flaps or seats or that they are made of rubber, rigid plastic or flexible vinyl.

Swidler '044 teaches an invention related to applying a temporary protective coating to the exterior surfaces of automobiles to protect those surfaces from rain and water (Abstract). Swidler '044 further teaches that it is known and desired in the art to apply temporary protective coatings to such automobiles components as plastic bumpers, thus rigid plastic, to protect those components (Column 7 Lines 35-40).

Art Unit: 1792

At the time the present invention was made it would have been obvious to one having ordinary skill in the art to apply the coating composition to a bumper of rigid plastic. Based on the teachings of Swidler '044, one of ordinary skill would have a reasonable expectation of success of applying the coating composition of Roberts et al to a bumper since it is known and desired in the art to apply temporary protective coatings to plastic bumpers components of automobiles.

### *Conclusion*

14. Claims 24 through 32 and 37 have been rejected. Claims 1 through 23 and 33 through 36 have been withdrawn from consideration as being a non-elected invention. No claims have been allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Wieczorek whose telephone number is (571)270-5341. The examiner can normally be reached on Monday through Friday; 7:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on (571)272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1792

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Wieczorek/  
Examiner, Art Unit 1792

/Michael Cleveland/  
Supervisory Patent Examiner, Art Unit 1792